



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/572,406

03/16/2006

David Gillespie

8008

60333 7590 08/31/2007
EDWIN D. SCHINDLER
FIVE HIRSCH AVENUE
P.O. BOX 966
CORAM, NY 11727-0966

EXAMINER

JACOB, AJITH

ART UNIT

PAPER NUMBER

2169

MAIL DATE

DELIVERY MODE

08/31/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/572,406

Applicant(s)

GILLESPIE, DAVID

Examiner

Ajith Jacob

Art Unit

2169

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 3/06
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. The instant application having Application No. 10/572406 has a total of 15 claims pending in the application, there are 1 independent claims and 14 dependent claims, all of which are ready for examination by the examiner.

Oath/Declaration

2. The applicant's oath/declaration has been reviewed by the examiner and is found to conform to the requirements prescribed in **37 C.F.R. 1.63**.

Claim Objections

3. Claim 25 is objected to because of the following informalities: The word "contianer" does not exist and the examiner assumes applicant meant to say "contained". Appropriate correction is required.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 15-29 are directed towards software, *per se*. The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*. Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33

Art Unit: 2169

F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994). Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.").

5. Claim 15 comprises of a smart folder for a selected set of documents and records, but does not specify a physical piece of hardware to fulfill the claim, and thus has been rejected.

6. Claims 16-29 does not solve any of the non-statutory deficiencies of claim 15, and thus are rejected for the reasons stated above.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 15-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Mushtaq et al. (EP 1,160,715 A2).

For claim 15, Mushtaq et al. teaches:

A smart folder for a selected set of documents or records having a unique identifier in a document management system [first folder stores documents with label fields, 0005], comprising: a predetermined set of rules applicable for a selected set of documents or records [template maker that does rule application, 0005]; and, software means for handling said selected set of documents or records [work flow maker handles template construction, 0005].

For claim 16, Mushtaq et al. teaches:

The smart folder for a selected set of documents or records according to Claim 15, wherein said smart folder contains at least one document or record of said selected set of documents or records [folder created when first document is saved, 0005].

For claim 17, Mushtaq et al. teaches:

The smart folder for a selected set of documents or records according to Claim 15, further comprising document metadata for said selected set of documents or records [folder having image for documents, 0031].

For claim 18, Mushtaq et al. teaches:

The smart folder for a selected set of documents or records according to Claim 17, wherein said document metadata includes at least one of document type, document status, keywords and custom properties [folder having description of documents, 0031].

For claim 19, Mushtaq et al. teaches:

The smart folder for a selected set of documents or records according to Claim 15, further comprising a set of permissions assigned to said smart folder for determining users permitted to modify or browse said smart folder, have access to said smart folder or add documents to said smart folder [setting and changing user access to folder, 0045-0046].

For claim 20, Mushtaq et al. teaches:

The smart folder for a selected set of documents or records according to Claim 15, further comprising software having record retention information means [process to determine retention, 0117].

For claim 21, Mushtaq et al. teaches:

The smart folder for a selected set of documents or records according to Claim 15, further comprising software means for an individual's record retention information to be overridden with software having different retention information, when so required [process manager determining if future users will benefit from retention of information, 0117].

For claim 22, Mushtaq et al. teaches:

The smart folder for a selected set of documents or records according to Claim 15, further comprising software having a templating function for allowing an authorized person for said smart folder to specify document metadata and permissions to be assigned to any documents or records stored in said smart folder, so that other users of

said smart folder, having valid permissions, are able to save documents or records into said smart folder [set write/read access to user or group access to folder, 0040-0047].

For claim 23, Mushtaq et al. teaches:

The smart folder for a selected set of documents or records according to Claim 22, wherein said document metadata and permissions specified in said software having said templating function includes means for applying said document metadata and permissions to the documents or records upon entry to said smart folder [private access setting that presets individual or group access to folder, so permission is set upon entry, 0040].

For claim 24, Mushtaq et al. teaches:

The smart folder for a selected set of documents or records according to Claim 15, further comprising a pointer to a parent folder of said smart folder [folder hierarchy creating a tree that points new folder to parent folder, 0035].

For claim 25, Mushtaq et al. teaches:

The smart folder for a selected set of documents or records according to Claim 15, further comprising software means so that when a smart folder is declared a "record," then all documents contained in said smart folder are also declared "records" [folder description for all documents, 0031].

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 2169

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mushtaq et al. as set forth above against claim 15 above, and in view of Johnson et al. (US 5,813,009).

As per claim 15, Mushtaq et al. teaches the storing of records in a smart folder [0005], but does not teach the deletion of records from the folder after a certain retention period.

Johnson et al. teaches the removal of all associated records upon time beyond retention [column 20, lines 65-67 – column 21, lines 1-5], the disposal process of removed data [column 21, lines 6-15], retention of data while time of disposal has not been reached [column 4, lines 60-67 – column 5, lines 1-8] and the disposal of records as an entirety [column 20, lines 56-64].

Mushtaq et al. (EP 1,160,715 A2) and Johnson et al. (US 5,813,009) are analogous art because they are from the same field of endeavor of storing records.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to modify the smart folder described by Mushtaq et al. and add the retention policy of records as described by Johnson et al.

The motivation for doing so would have been to solve the “portion of the overall business problem which deals with the timely disposal of archived imaged records” [column 3, lines 10-22].

Therefore, it would have been obvious to combine Mushtaq et al. (EP 1,160,715 A2) with Johnson et al. (US 5,813,009) for the benefit of deleting outdated contents from records.

Conclusion

The Examiner requests, in response to this Office action, that support be shown for language added to any original claims on amendment and any new claims. That is, indicate support for newly added claim language by specifically pointing to page(s) and line no(s) in the specification and/or drawing figure(s). This will assist the Examiner in prosecuting the application.

When responding to this Office action, Applicant is advised to clearly point out the patentable novelty which he or she thinks the claims present, in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections See 37 CFR 1.111(c).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajith Jacob whose telephone number is 571-270-1763. The examiner can normally be reached on M-F 7:30-5:00 EST, Every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mohammad Ali can be reached on 571-272-4105. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2169

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

8/8/2007 KOP

AJ

AJ
Patent ExaminerMOHAMMAD ALI
PRIMARY EXAMINER